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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,440	02/19/2002	David A. Caughey	132-03 US	9855
25319	7590	10/24/2005	EXAMINER	
FREEDMAN & ASSOCIATES 117 CENTREPOINTE DRIVE SUITE 350 NEPEAN, ONTARIO, K2G 5X3 CANADA			AILES, BENJAMIN A	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,440

Applicant(s)

CAUGHEY, DAVID A.

Examiner

Benjamin A. Ailes

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the Amendment filed 23 August 2005.
2. Claims 1-17 remain pending.

Specification

3. The amendment to the Abstract has been entered into the record and overcomes the prior objection. The objection to the abstract has been withdrawn.

Claim Objections

4. The amendment to claim 11 has been entered into the record and overcomes the prior objection. The objection to claim 11 has been withdrawn.

Response to Arguments

5. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 6, 9, 11 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper (U.S. 6,883,000 B1) in view of Schiller (U.S. 2001/0032089 A1).

8. Regarding claim 1, Gropper discloses a method of adding a new contact to an electronic contact information database comprising the steps of:

(a) recognizing data stored in an electronic contact information database of a user system as data relating to contact information of a new contact (col. 5, lines 16-29, Gropper discloses a method of a user entering in a person or business' contact information using a Universal Contact Locator (UCL), which may be a person's e-mail address (see col. 4, lines 43-56). The client program automatically recognizes when a new contact's information is entered and stores the entered UCLs in a list.);

(b) extracting from the stored data a contact destination of the new contact (col. 5, lines 37-41, Gropper discloses a method of extracting the UCL of the new contact. The UCL providing information relating to the contact's contact destination.);

(c) automatically sending a message including a request for additional contact information to the contact destination of the new contact. Gropper discloses a method wherein once the client station connects to the Internet the client station sends a request to the server for additional contact information linked to the contact's UCL (col. 5, lines 37-45) but does not explicitly disclose the request for additional contact information being sent directly to the new contact. However, Schiller discloses an operation of a contact database wherein update requests are sent in the form of electronic messages directly to the contact's email address in order for the contact to be able to provide updated information. One

of ordinary skill in the art at the time of the applicant's invention would have found it obvious to implement the step of sending a message directly to a contact requesting updated information as disclosed by Schiller in combination with the contact management database disclosed by Gropper. One of ordinary skill in the art would have been motivated to implement this step in order for a user to be able to have an up to date contact database that is constantly being updated by the best person, the best person being the person who updates information in respect to themselves (see Schiller, page 2, paragraph [0021]); and

(d) upon receiving a return message including additional contact information from the new contact, automatically updating the contact information database with the additional contact information (col. 5, line 63 – col. 6, lines 4, Gropper discloses the method wherein the server system sends a message back containing the appropriate information (the contact's additional contact information). Once this information has been received at the client, the contact data is stored in the appropriate locations (i.e. CMS, PIM).).

9. Claims 14, 15, and 16 contain similar subject matter and are rejected under the same rationale as claim 1 above.

10. Claim 9 contains similar subject matter and is rejected under the same rationale as claim 1. Regarding the use of an inbox the method of storing messages within the inbox, Schiller discloses the use of an e-mail application to send and receive electronic messages (see figures 3 and 5, i.e. Microsoft Outlook), therefore it is deemed inherent for the e-mail application to include an e-mail inbox as is well known in the art.

11. Regarding claim 6, Gropper discloses the ability for a user to verify personal information and update information accordingly (i.e. change of address, see col. 6, lines 54-57) but does not explicitly, as stated above in the rejection of claim 1, the step of requesting for additional contact information being sent directly to the new contact. However, Schiller discloses an operation of a contact database wherein update requests are sent in the form of electronic messages directly to the contact's email address in order for the contact to be able to provide updated information. The user then either updates contact information or returns the message with a message confirming that no update is necessary. One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to implement the step of sending a message directly to a contact requesting updated information as disclosed by Schiller in combination with the contact management database disclosed by Gropper. One of ordinary skill in the art would have been motivated to implement this step in order for a user to be able to have an up to date contact database that is constantly being updated by the best person, the best person being the person who updates information in respect to themselves (see Schiller, page 2, paragraph [0021]).

12. Regarding claim 11, as mentioned in above in the rejection of claim 9, Schiller discloses the use of an e-mail application to send and receive electronic messages (see figures 3 and 5, i.e. Microsoft Outlook), therefore it is deemed inherent for the e-mail application to include an e-mail inbox as is well known in the art. It is also deemed inherent for e-mail applications to have the ability to store electronic messages in separate folders (i.e. new, trash, deleted, old...).

13. Claims 2-5, 7, 8, 10, 12, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper.

14. Regarding claim 2, Gropper discloses the method wherein the stored data is provided manually by the user (col. 5, lines 16-23, Gropper discloses a method wherein a user enters information about a new contact manually into a computer.).

15. Regarding claim 3, Gropper discloses the method wherein the stored data is provided automatically by an electronic message application in execution on the user system (col. 5, lines 37-45, Gropper discloses a method wherein once the client station connects to the Internet the client station sends a request to the server for additional contact information linked to the contact's UCL. col. 5, line 63 – col. 6, lines 4, Gropper discloses the method wherein the server system sends a message back containing the appropriate information (the contact's additional contact information). Once this information has been received at the client, the contact data is stored in the appropriate locations (i.e. CMS, PIM).).

16. Regarding claim 4, Gropper discloses the method wherein the message is an electronic message and wherein step d) includes the step of:

automatically extracting the additional contact information from the received return electronic message (col. 5, line 63 – col. 6, lines 4, Gropper discloses the method wherein the server system sends a message back containing the appropriate information (the contact's additional contact information). Once this information has been received at the client, the contact data automatically extracted and is stored in the appropriate locations (i.e. CMS, PIM).).

17. Regarding claims 5 and 17, Gropper discloses the method wherein the user is a subscriber to a contact list update service and wherein the new contact is other than a subscriber to the contact list update service (col. 4, line 64 – col. 5, line 3, Gropper discloses the method wherein the user is a subscriber to the contact list update service (see col. 5, lines 10-15) and the 'new contact' does not have to be a subscriber to the service, wherein the subscriber can also use the client program as a general 'personal address book').).

18. Regarding claim 7, Gropper discloses the method wherein the electronic message comprises message body text containing contact information for at least one contact information field for verification. (col. 5, lines 16-29, Gropper discloses a method wherein an electronic message is sent comprising a UCL code sent to the server system for verification.).

19. Regarding claim 8, Gropper discloses the method wherein the return message is generated by an automated reply filter in execution on the contact system using contact information retrieved from a memory accessible to the automated reply filter (col. 5, lines 48-51, Gropper discloses the method wherein a request for contact information is submitted to a server system and the server system automatically retrieves the requested contact information and submits the information back to the requesting system.).

20. Regarding claim 10, Gropper discloses the method wherein the return message is generated by an automated reply filter in execution on the contact system using contact information retrieved from a memory accessible to the automated reply filter

(col. 5, lines 48-51, Gropper discloses the method wherein a request for contact information is submitted to a server system and the server system automatically retrieves the requested contact information and submits the information back to the requesting system.).

21. Regarding claim 12, Gropper discloses the method comprising the steps of: receiving the transmitted new electronic message at the user system (col. 5, lines 48-51, Gropper discloses the contact information being transferred to the user system); automatically extracting from the received new electronic message the current contact information for the new contact (col. 5, lines 66 – col. 6, line 2, Gropper discloses the client program stores appropriate contact data to appropriate locations). automatically storing the extracted current contact information in association with other contact information relating to the new contact within the contact database of the user system (col. 5, line 66 – col. 6, line 4, Gropper discloses storing contact data in appropriate locations (contact manager databases, i.e. PIM).

22. Claim 13 contains similar subject matter and is rejected under the same rationale as claims 9 and 12.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2142

Birrell et al. (U.S. 6,185,551 B1) disclose a web-based electronic mail service apparatus and method using full text and label indexing.

Macholda (U.S. 2002/0169748 A1) discloses a self-updating address book containing a list of contacts and the profile of its own user.

Celik (U.S. 6,374,259 B1) discloses a method and apparatus for storing and retrieving business contact information in a computer system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-3899. The examiner can normally be reached on M-F 6:30-4, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beatriz Prieto
BEATRIZ PRIETO
PRIMARY EXAMINER

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